

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
(Case No. 05-783)

In the Application of:)
)
 Richard D. Heal et al.) Examiner: Jason M. Sims
)
Serial No. 10/551,070))
) Group Art Unit: 1631
Filed: September 27, 2005))
) Conf. No. 6312
Title: Method and System for Analysis of Compounds)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

REPLY TO THE RESTRICTION REQUIREMENT

This is a Reply to the December 17, 2008 Restriction Requirement for the above-identified patent application. The Applicant traverses the restriction requirement and provides a provisional election below.

I. THE TRAVERSE

The examiner requires restriction of the claims of the above identified invention to one of two allegedly distinct inventions – Group I claims 1-2 and 10-11 or Group II claims 3-9. This application is a PCT national phase application. Therefore, any restriction requirement for this application must be based upon a unity of invention claim analysis.

The examiner identifies the alleged special technical feature of the invention to be “the cluster analysis vector quantities representative of feature changes derived from an array. The examiner takes the position that the alleged special technical feature is an “obvious variation” of analyzing vector quantities of features derived from an array as set forth in the Szabo et al reference thereby preventing the claims from having a common inventive concept.

The Applicant’s traverse the examiner’s restriction requirement on at least two grounds. Firstly, the examiner has too narrowly construed to special technical feature common to all of the claims. Secondly, the examiner’s evaluation of whether or not the special technical feature is found

in the prior art is incomplete. Each of these reasons requires the examiner to withdraw the restriction requirement.

A. The Examiner Incorrectly Identified The Common Special Technical Features

It is the examiner's position that the special technical features common to all claims is "the cluster analysis vector quantities representative of feature changes derived from an array." The examiner's characterization of the common special technical features is incomplete. A review of all pending claims shows that all claims except claim 9 share the following features that are believed to contribute to claim patentably:

- A number of features derived from an electrical output;
- A number of dimensions equal to the number of features; and
- Determin[ing] a vector quantity having a number of dimensions equal to a number of features derived from the electrical output of said [system] with each component of said vector being representative of a change in said feature,

The examiner's characterization of the claim common special technical features is overly broad and incorrect. The proper special technical features include features not found in the Szabo et al. reference such as features derived from an electrical input and dimensions equal to the number of features. For at least this reason, claims 1-8 and 10-11 should be examined together.

B. The Examiner's Evaluation Of The Patentability Of The Alleged Common Special Technical Features Is Incomplete

The examiner's dismissal of the alleged common special technical feature as "an obvious variation" of vectors disclosed in the cited prior art Szabo et al. reference is inadequate to demonstrate lack of novelty or clear obviousness of the examiner's recited special technical features. Cited paragraph [0007] of Szabo et al. merely discloses that vectors can be used to define feature variables in, for example, microarray analysis. While the examiner maintains that the claimed special technical features are an obvious variant over the Szabo et al. vectors, the examiner has not cited other prior art or any other basis – such as official notice – that supports the examiner's obvious variant position. As it stands, the examiner's analysis of the alleged special technical features is incomplete and it is improper to refuse to consider all claims together without some showing – other than the examiner's conclusory statement - that the alleged common special technical features are "clearly obvious". For this reason, the examiner's restriction requirement must be withdrawn and claims 1-11 must be considered together in this application.

II. PROVISIONAL ELECTION

In accordance with 37 CFR 1.499, the Applicant provisionally elects to proceed with examination Group II claims 3-9.

Date: January 14, 2009

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